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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,892	11/18/2003	Richard Ormson	WN-2619	2814
21254	7590	08/23/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			BALAOING, ARIEL A	
		ART UNIT	PAPER NUMBER	2683

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/714,892	ORMSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ariel Balaong	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 November 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1.) Certified copies of the priority documents have been received.  
 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### **Content of Specification**

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- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet

published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (I) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: The meaning of the term "BA list" cited on paragraphs 10, 24, 30, 32 is unclear.

***Claim Rejections - 35 USC § 112***

2. Claims 3, 10, 12, 14 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "BA list" is recited in claims 3 and 10. It is unclear as to what "BA list" refers to.

3. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by OTTING et al (US 6,477,372 B1).

Regarding claim 1, OTTING discloses a method of network acquisition for a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and comprising searching to identify a suitable cell on one radio technology (abstract) and, subsequent to identifying a suitable cell on the said one radio technology, comprising the steps of also monitoring cells on another of the plurality of radio technologies in order to identify if one of the said monitored cells is more suitable than the cell identified on the said one radio technology (column 4:lines 17-59; column 6:lines 10-46), and subsequent to said monitoring, selecting and camping for the first time on the cell identified from all of the radio technologies searched as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. OTTING further discloses wherein the step of monitoring the cells on the said another RAT comprises monitoring neighboring cells on all of the plurality of RATs (column 4:lines 17-59; column 6:lines 10-46).

Regarding claim 6, OTTING discloses a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies (abstract) and

including means for searching to identify a suitable cell on one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46) and means for monitoring cells on another of the plurality of radio technologies (abstract; column 4:lines 17-59; column 6:lines 10-46), subsequent to the identification of a suitable cell on the said one radio technology, so as to identify if one of the said monitored cells might prove more suitable than the said identified cell (abstract; column 4:lines 17-59; column 6:lines 10-46), and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46).

Regarding claim 7, OTTING discloses A cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and including means for searching to identify a suitable cell on one radio technology (abstract) and means for monitoring cells on another of the plurality of radio technologies (abstract; column 4:lines 17-59; column 6:lines 10-46), subsequent to the identification of a suitable cell on the said one radio technology, so as to identify if one of the said monitored cells might prove more suitable than the said identified cell (abstract; column 4:lines 17-59; column 6:lines 10-46), and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46) and arranged to operate in accordance with the method of claim 2 (abstract; column 4:lines 17-59; column 6:lines 10-46).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over OTTING et al (US 6,477,372 B1) in view of EINOLA (US 5,960,354).

Regarding claim 3 and 10, see the rejections of the parent claims concerning the subject matter these claims are dependant upon. However, OTTING does not disclose

wherein the step of monitoring cells on the said another RAT includes the step of obtaining BA list on the said identified cell but for all of the plurality of other RATs read. EINOLA discloses wherein the step of monitoring cells on the said another RAT includes the step of obtaining BA list on the said identified cell but for all of the plurality of other RATs read (column 6:line 60-column 7:line 4). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to include the step of obtaining a BA list for a plurality of RATs, as both systems relate to multimode mobile devices. This is beneficial in that obtaining a list of BCCHs to monitor speeds of the process of scanning for appropriate cells for handover.

Regarding claim 15, OTTING discloses a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies (abstract) and including means for searching to identify a suitable cell on one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46) and means for monitoring cells on another of the plurality of radio technologies, subsequent to the identification of a suitable cell on the said one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46), so as to identify if one of the said monitored cells might prove more suitable than the said identified cell (abstract; column 4:lines 17-59; column 6:lines 10-46), and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46). However, OTTING does not disclose wherein the step of monitoring cells on the said another RAT includes the step of obtaining BA list on the said identified cell but for all of the plurality of other RATs read. EINOLA discloses

wherein the step of monitoring cells on the said another RAT includes the step of obtaining BA list on the said identified cell but for all of the plurality of other RATs read (column 6:line 60-column 7:line 4). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to include the step of obtaining a BA list for a plurality of RATs, as both systems relate to multimode mobile devices. This is beneficial in that obtaining a list of BCCHs to monitor speeds of the process of scanning for appropriate cells for handover.

10. Claims 4, 5, 11, 13, 16, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over OTTING et al (US 6,477,372 B1) in view of BRODY (US 4,670,899).

Regarding claims 4 and 11, see the rejections of the parent concerning the subject matter these claims are dependant upon. However, OTTING does not disclose wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom. BRODY discloses wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom (column 18:lines 1-12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

Regarding claims 5 and 13, see the rejections of the parent concerning the subject matter these claims are dependant upon. However, OTTING does not disclose wherein the step of identifying a suitable cell includes determining a derivative of the

strength of a signal received therefrom. BRODY discloses wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom (column 19:lines 19-48). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

Regarding claim 16, OTTING discloses a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies (abstract) and including means for searching to identify a suitable cell on one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46) and means for monitoring cells on another of the plurality of radio technologies, subsequent to the identification of a suitable cell on the said one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46), so as to identify if one of the said monitored cells might prove more suitable than the said identified cell (abstract; column 4:lines 17-59; column 6:lines 10-46), and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46). However, OTTING does not disclose wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom. BRODY discloses wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom (column 18:lines 1-12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made

to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

Regarding claim 17, OTTING discloses a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies (abstract) and including means for searching to identify a suitable cell on one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46) and means for monitoring cells on another of the plurality of radio technologies, subsequent to the identification of a suitable cell on the said one radio technology (abstract; column 4:lines 17-59; column 6:lines 10-46), so as to identify if one of the said monitored cells might prove more suitable than the said identified cell (abstract; column 4:lines 17-59; column 6:lines 10-46), and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable (abstract; column 4:lines 17-59; column 6:lines 10-46). However, OTTING does not disclose wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom. BRODY discloses wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom (column 19:lines 19-48). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to

cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

11. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over OTTING et al (US 6,477,372 B1) in view of EINOLA (US 5,960,354) and further in view of BRODY (US 4,670,899).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, OTTING does not disclose wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom. BRODY discloses wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom (column 18:lines 1-12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

Regarding claim 14, However, OTTING does not disclose wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom. However, OTTING does not disclose wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom. BRODY discloses wherein the step of identifying a suitable cell includes determining a derivative of the strength of a signal received therefrom (column 19:lines 19-48). Therefore it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to modify OTTING to determine cell suitability based on a received signal strength, as taught by BRODY, as both systems relate to cell selection. This is beneficial in that higher quality connections can be achieved when cells are above a determined threshold.

***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1, 4, 5, and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 7, and 10 of copending Application No. 10/714847. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 4, 5, and 6 of the present application are a broader version of claims 1, 6, 7, and 10 of copending Application No. 10/714847 as follows.

Claim 1 of copending Application No. 10/714847 includes all of the limitations of claim 1 of the instant application as follows:

A method of network acquisition for a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and comprising searching to identify a suitable cell on one radio technology and, subsequent to identifying a suitable cell on the said one radio technology, comprising the steps of also monitoring cells on another of the plurality of radio technologies in order to identify if one of the said monitored cells is more suitable than the cell identified on the said one radio technology, and subsequent to said monitoring, selecting and camping for the first time on the cell identified from all of the radio technologies searched as the most suitable.

However, claim 1 also includes the following limitations: determining the most suitable cell "based on a characteristic of signals received", that "signals from each cell being provided over a band of frequencies", that measurements are taken "for each frequency", and "each determined frequency is compared with a predetermined value" to indicate a suitable cell.

Nonetheless, the removal of said limitations from claim 1 of the present application made claim 1 a broader version of claim 1 of the copending application. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Carlson* (CCPA) 136 USPQ 184 (1963)), claim 1 is not patentably distinct from claim 1 of the copending application.

Claim 6 of copending Application No. 10/714847 all the limitations of claim 4 of the instant application as follows:

A method of network acquisition for a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and comprising searching to identify a suitable cell on one radio technology and, subsequent to identifying a suitable cell on the said one radio technology, comprising the steps of also monitoring cells on another of the plurality of radio technologies in order to identify if one of the said monitored cells is more suitable than the cell identified on the said one radio technology, and subsequent to said monitoring, selecting and camping for the first time on the cell identified from all of the radio technologies searched as the most suitable; wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom.

However, claim 6 also includes the following limitations: determining the most suitable cell "based on a characteristic of signals received", that "signals from each cell being provided over a band of frequencies", that measurements are taken "for each frequency", and "each determined frequency is compared with a predetermined value" to indicate a suitable cell.

Nonetheless, the removal of said limitations from claim 4 of the present application made claim 4 a broader version of claim 6 of the copending application. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 1 is not patentably distinct from claim 1 of the copending application.

Claim 7 of copending Application No. 10/714847 all the limitations of claim 5 of the instant application as follows:

A method of network acquisition for a cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and comprising searching to identify a suitable cell on one radio technology and, subsequent to identifying a suitable cell on the said one radio technology, comprising the steps of also monitoring cells on another of the plurality of radio technologies in order to identify if one of the said monitored cells is more suitable than the cell identified on the said one radio technology, and subsequent to said monitoring, selecting and camping for the first time on the cell identified from all of the radio technologies searched as the most suitable; wherein the suitability of the cells is determined on the basis of the strength of a signal received therefrom.

However, claim 7 also includes the following limitations: determining the most suitable cell "based on a characteristic of signals received", that "signals from each cell being provided over a band of frequencies", that measurements are taken "for each frequency", and "each determined frequency is compared with a predetermined value" to indicate a suitable cell.

Nonetheless, the removal of said limitations from claim 5 of the present application made claim 5 a broader version of claim 7 of the copending application. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson*

(CCPA) 136 USPQ 184 (1963)), claim 1 is not patentably distinct from claim 1 of the copending application.

Claim 10 of copending Application No. 10/714847 all the limitations of claim 6 of the instant application as follows:

A cellular radio communications device arranged for operation in accordance with a plurality of radio technologies and including means for searching to identify a suitable cell on one radio technology and means for monitoring cells on another of the plurality of radio technologies, subsequent to the identification of a suitable cell on the said one radio technology, so as to identify if one of the said monitored cells might prove more suitable than the said identified cell, and further including means for, subsequent to the said monitoring, selecting and camping on the cell identified as the most suitable.

However, claim 10 also includes the following limitations: determining the most suitable cell "based on a characteristic of signals received", that "signals from each cell being provided over a band of frequencies", that measurements are taken "for each frequency", and "each determined frequency is compared with a predetermined value" to indicate a suitable cell.

Nonetheless, the removal of said limitations from claim 6 of the present application made claim 6 a broader version of claim 10 of the copending application. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson*

(CCPA) 136 USPQ 184 (1963)), claim 1 is not patentably distinct from claim 1 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IMURA (US 6,185,435 B1) – Communicating with a plurality of different communication systems

KHULLAR (US 6,748,246) – Selecting an access technology in a multi-mode terminal

CELEDON et al (US 2003/0190916 A1) – Optimizing cell neighbor lists

ALMGREN et al (US 6,212,384 B1) – Radio signal source identification system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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